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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,098	08/25/2003	Moshe Rock	10638-052002	6437
26161	7590	11/17/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SINGH, ARTI R	
			ART UNIT	PAPER NUMBER
			SIRA	
DATE MAILED: 11/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

11

Office Action Summary	Application No. 10/650,098	Applicant(s) ROCK ET AL.	
	Examiner Ms. Arti Singh	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>several</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Restriction

1. Applicant's election without traverse of Claims 1-10 in the reply filed on 09/02/05 is acknowledged.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 08/25/03 and 10/12/04 have been considered by the examiner, and are being remitted herewith.

Specification

3. The disclosure is objected to because of the following informalities: the first paragraph of the specification needs to be update with the correct and updated continuity data. Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7-9, 12, 16, 18, 20, 21, 24-29 & 31 of U.S. Patent No. 5,364,678. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent represent a species of the instant invention and therefore suggest the instant claims.

6. Claims 1-10 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 10, 13-19, 21, 26 & 29-31 of U.S. Patent No. 5,204,156. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent represent a species of the instant invention and therefore suggest the instant claims.

7. Claims 1-10 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 9 & 14-19 of U.S. Patent No. 5,268,212. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant patent and the application claim the same subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by Lumb et al. (USPN 5,364,678). Lumb et al. teach a stretchable, drapable, windproof, water resistant and water

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vapor permeable composite fabric. The composite fabric includes an inner fabric layer, an outer fabric layer and a non-porous hydrophilic barrier layer, said outer and inner layers and an essentially hydrophilic adhesive layer joining both the inner and outer layers with the barrier. The adhesive and the barrier layers are constructed to prevent air from passing through the fabric layers while allowing water vapor to travel there through by a process of absorption-diffusion-desorption, but restrict the passage of wind and liquid water (column 2, lines 9-23). The adhesive may be continuous or discontinuous (abstract and column 4, lines 11-65, column 5, lines 1). The inner fabric layer maybe made from a variety of materials and may have a raised inner surface (column 2, lines 26-38). The barrier layer may be formed from a polyurethane (column 2, line 50 and column 4, line 32). The overall composite fabric is stretchable, windproof and water-resistant. Given that Lumb et al. meet each and every chemical and structural requirement set forth in the claims, then it must meet the property limitations of airflow recited that depend from said requirements. In other words, it is reasonable to presume that the invention of Lumb et al. would inherently anticipate the physical properties of the present invention, since both inventions are comprised of the same fabric and barrier layers. Furthermore, as no other structural or chemical features are claimed which may distinguish the present invention from that of the Lumb et al. invention, the presently claimed physical properties of airflow are deemed to be inherent to the invention of Lumb et al. The burden is upon Applicant to prove otherwise. Note *In re Fitzgerald 205 USPQ 495*. Without a showing that evidences a difference between the prior art and the present invention, anticipation is proper.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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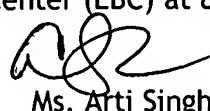
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. (US 5,364,678). Lumb et al. disclose what is set forth above but do not specifically teach the adhesive to be foamed, however the Examiner takes Official Notice that it is well known in the art of adhesives to foam or add air into the adhesive mixture so as to use less adhesive and cover more area (unit per volume) of the desired surface that requires the adhesive. A person having ordinary skill in the art at the time the invention was made would have found it obvious to have used a foam adhesive for the reasons well known in the art along with it being more economical and to make it more porous. Further support for the use of foamed adhesives can be seen in Applicant's patent US 5,126,182.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-F 9-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ms. Arti Singh

Ms. Arti R. Singh
Primary Examiner
Tech Center 1700